



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/374,408

08/13/99

ANDREWS

C

ANDREWS-0080

WM02/0731

JONATHAN O OWENS
HAVERSTOCK & OWENS LLP
SUITE 420
260 SHERIDAN AVENUE
PALO ALTO CA 94306

EXAMINER

FOSTER, R

ART UNIT

PAPER NUMBER

2645

DATE MAILED:

07/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/374,408

Applicant(s)

ANDREWS, CHRISTOPHER C.

Examiner

Roland G. Foster

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

On page 10, paragraph 2 of the amendment, filed on Feb. 23, 2001 as Paper No. 4, the applicant remarks with respect to the invention in contrast to Bobo:

"An e-mail notification is also preferably sent to the recording user notifying the recording user of the address at which the recorded audio file can be accessed."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., e-mail notification sent to the recording user notifying the recording user of the address at which the recorded audio file can be accessed) are not recited in the rejected claim(s). For example, see claim 12 which appears to recite a feature similar to the above cited feature except that "e-mail" is not recited. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 11, paragraph 3 of the amendment, the applicant remarks:

"As discussed above, Bobo teaches that to obtain a message such as a facsimile message, the user selects an anchor for a facsimile list. In response to this selection, the system of Bobo then displays a file containing the list of facsimiles. Bobo does not teach that the facsimile messages are accessible other than through this facsimile list."

Although the applicant's remarks have been duly considered, they are not deemed fully persuasive. Although Bobo teaches that facsimiles (and also voice

Art Unit: 2645

messages or recorded audio files) are first accessed via a web page containing links to the faxes and voice messages, it is not clear why the URL for this web page could not be considered a separately and independently accessible address for the recorded audio file. For example, Bobo teaches that the URL is accessible via the WWW at virtually any location in the world (col. 18, lines 34-44). An address that is accessible via the WWW at virtually any location in the world can be considered a separately and independently accessible address. For example, a separate computer is capable of "separately" accessing the recorded audio file somewhere else on the WWW.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 and 44-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The subject claims recite specifying an address. However, it is not clear whether the "notification" or "audio communication" specifies the address. As consistent with the specification, the claim will be interpreted as if the notification specifies the address. Nonetheless, correction of the claim is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-11, 13-19, and 21-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Bobo, II (U.S. Patent No. 5,675,507) [Hereinafter Bobo], of record.

With respect to claim 1, the following paragraphs for additional details on how Bobo anticipates particular limitations in the claim.

“a. establishing a telephony connection between a telephony device and a call recording device” reads on Figs. 1 and 2, where a telephone call (telephony connection) is established between Telephone Set (26) (telephony device) and a call recording device (Message Storage and Delivery System) (MSDS) (10).

“b. recording an audio communication transmitted over the telephony connection thereby establishing a recorded audio file” reads on Fig. 2, step (52).

Art Unit: 2645

"c. associating an independently accessible address with the recorded audio file, such that when the address is accessed using the computer system, the recorded audio file is transmitted to the computer system for playback" reads on Fig. 1, Fig. 3, step (62), Fig. 8, and col. 7, lines 25-31 where the user enters a URL (address) at a Computer with a hypertext browser (32) (computer system) to access the MSDS (10). The URL (html address) is associated with the recorded audio file in that the URL is associated with the MSDS (10) mailbox where the recorded audio file is stored. The audio file is converted into a format appropriate for HTML linking, such as AU or WAV and transmitted to Computer (32) (computer system). See also col. 12, line 63 – col. 13, line 23. The phrase "independently accessible address" is extremely broad. For example, a Uniform Resource Locator (URL) address of Bobo associated with the recorded audio file is an address independently accessible by any computer browser connected to the World Wide Web (WWW). "...wherein the recorded audio file is separately accessible using the independently accessible address" reads on col. 18, lines 35-56 where the recorded audio file is accessible via the WWW at "virtually any location in the world". An address that is accessible via the WWW at virtually any location in the world can be considered a separately and independently accessible address. For example, a separate computer is capable of "separately" accessing the recorded audio file somewhere else on the WWW.

Art Unit: 2645

Claim 17 differs substantively from claim 1 in that claim 1 recites the following limitation: "c. including the recorded audio file within a second file, such that when the second file is accessed using the computer system, the recorded audio file is available for playback at the computer system" This limitation reads on reads on col. 13, lines 5-15 where each audio html files (second file) includes an anchor to the actual audio file (i.e., 1.wav).

Claim 22 differs substantively from claim 1 in that claim 22 recites the means to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. "A. means for establishing a telephone connection..." reads on Fig. 1, Telephone Set (26). "B. Means for recording...." and "C. Means for storing..." reads on Fig. 1, MSDS (10).

Claim 30 differs substantively from claim 22 in that claim 30 recites a "circuit" and "systems" to instead of "means" as in claim 22. However, the "circuit" and "systems" reads on the "means" of claim 22. Therefore, the claim 22 rejection for any further details.

Claim 37 differs substantively from claim 1 in that claim 37 recites a "server" and "systems" to perform the method steps of claim 1. . Therefore, see the claim 1 rejection for any additional details. "a. a call processing and recording system..." reads on Fig. 13, Central Processor (3). "b. a server coupled to the call processing and recording

Art Unit: 2645

system..." reads on Fig. 13, Internet Server (5). Note that Fig. 13 illustrates the various systems that comprise MSDS (10). See also col. 16, lines 47 – 67. "c. one or more computer systems..." reads on Fig. 1, Computer (32).

With respect to claim 2, see Fig. 13, Internet Server (5) and col. 17, lines 37-43.

With respect to claim 3, see Fig. 8 and col. 12, line 63 – col. 13, line 23. Note that the address (URL) is accessed when the audio file is retrieved.

With respect to claims 4, 28, and 42, see col. 13, lines 10-15 where the user selects an anchor (hyperlink) to access a voice message (audio file). Although the anchor (hyperlink) may be a simple HREF command referring to the voice message (audio file), selecting the hyperlink would still result in the html address (URL) corresponding to user's mailbox on the Internet Server (5) being sent to Internet Server (5) in order for the browser to request and retrieve the voice message (audio file) from Internet Server (5).

With respect to claims 5, 25, 26, 33, and 34, see Fig. 1 where an Internet (data) connection is established between the Computer (32) and the MSDS (10) in order to play back recorded audio (col. 12, line 63 – col. 13, line 33).

Art Unit: 2645

With respect to claims 6, 29, 36, and 43, see col. 13, lines 10-15 and the claim 4 rejection above.

With respect to claims 7, 19, 24, 32, and 39, see Fig. 13 where the Internet Server (5) (server) is remote from the Computer (32) (computing system).

With respect to claim 9, the message storage process of Fig. 2 and message retrieval process of Fig. 3 are separated by time. The phrase “recorded audio file is first available for playback” is a broad term. For example, an audio file may be only considered “available” to the user when the user has established an Internet connection and successfully logged onto the MSDS (10) by entering a correct login id and password. If the user is unable to log onto the MSDS (10), then the audio files are “unavailable” to the user.

With respect to claim 10, the user inherently has the ability to specify the “time” by simply deciding when to attempt to log onto the MSDS (10) (see the claim 9 rejection above) and review messages, such as immediately after the recording was made or after a lengthy delay period.

With respect to claim 11, a “location profile” is a broad enough phrase to correspond to the time zone that the MSDS (10) resides in because the time zone is a significant feature that helps to “profile” the location of MSDS (10). The time zone that

Art Unit: 2645

the MSDS (10) is located in would in turn determine the "time" when remote users log onto the MSDS (10) from areas outside the time zone. As stated in the claim 10 rejection, the "time" that user logs onto the MSDS (10) specifies the range when the recorded audio file is first available for playback.

With respect to claim 13, see col. 8, lines 10-20 and col. 13, lines 16-18.

With respect to claim 14, the link is posted in a predetermined location, namely in the MSDS (10).

With respect to claim 15, see col. 13, lines 13-14.

With respect to claim 18, the web server would serve the html file and anchored audio file.(step of including is performed by a server).

With respect to claims 23, 31, and 38, see Fig. 15, Storage (11).

With respect to claim 27, see Fig. 13, Internet Server (5).

With respect to claim 35, see Fig. 15, Storage (11) where the html files are addressed via the Internet (30).

With respect to claim 40, see col. 6, lines 20-22.

With respect to claim 41, see Fig. 1.

Claims 1, 8, 17, 20, 22, 30 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Uppaluru (U.S. Patent No. 5,915,001), of record. Uppaluru teaches of a system for providing speech files that are accessible via the Internet. Significantly, Uppaluru also teaches of allowing users to make the speech files accessible (publishing the speech files) using a telephonic connection.

With respect to claim 1, the following paragraphs for additional details on how Uppaluru anticipates particular limitations in the claim.

“a. establishing a telephony connection between a telephony device and a call recording device” reads on col. 20, lines 4-10.

“b. recording an audio communication transmitted over the telephony connection thereby establishing a recorded audio file” reads on col. 21, lines 10-13.

“c. associating an independently accessible address with the recorded audio file, such that when the address is accessed using the computer system, the recorded audio filed is transmitted to the computer system for playback” reads on col. 21, lines 25-29

Art Unit: 2645

where a URL (address) is associated with the recorded audio files. See also col. 7, lines 13-67. The URL can then be accessed telephonically (col. 7, lines 28-39) or via a WWW browser (col. 7, lines 20-21). The phrase "independently accessible address" is extremely broad. For example, the URL address of Uppaluru associated with the recorded audio file is an address independently accessible by any computer browser connected to the WWW. "...wherein the recorded audio file is separately accessible using the independently accessible address" reads on col. 7, lines 20-23 where the recorded audio file is accessible via the WWW at virtually any location in the world. An address that is accessible via the WWW at virtually any location in the world can be considered a separately and independently accessible address. For example, a separate computer is capable of "separately" accessing the recorded audio file somewhere else on the WWW.

Claim 17 differs substantively from claim 1 in that claim 1 recites the following limitation: "c. including the recorded audio file within a second file, such that when the second file is accessed using the computer system, the recorded audio file is available for playback at the computer system" reads on the embedding process of col. 7, lines 34-35.

Claim 22 differs substantively from claim 1 in that claim 22 recites the means to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. "a. means for establishing a telephone connection..." reads on Fig.

Art Unit: 2645

1, Telephone Set (111). “b. means for recording....” reads on Fig. 1, Voice and Telephony Interface 114 and col. 6, lines 23-30. “c. means for storing...” reads on Fig. 1, Voice Web Site 102.

Claim 30 differs substantively from claim 22 in that claim 30 recites a “circuit” and “systems” to instead of “means” as in claim 22. However, the “circuit” and “systems” reads on the “means” of claim 22. Therefore, the claim 22 rejection for any further details.

Claim 37 differs substantively from claim 1 in that claim 37 recites a “server” and “systems” to perform the method steps of claim 1. . Therefore, see the claim 1 rejection for any additional details. “a. a call processing and recording system...” reads on Fig. 1, Voice and Telephony Interface 114. “b. a server coupled to the call processing and recording system...” reads on Fig. 1, Voice Web Site 102.

With respect to claims 8 and 20, see col. 1, lines 33-67.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 44-47, as they can best be understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Uppaluru as applied to claims 1, 17, 22, 30 and 37 above.

Uppaluru fails to specifically disclose sending a notification to a recording user responsible for recording the audio communication where the notification specifies an independently accessible address associated with the recorded audio file.

However, Uppaluru teaches that the user who recently published a business yellow page as discussed above (see the claim 1 rejection) may access that page in the business yellow pages searching program (col. 20, lines 35-67). Note that the user has the ability to browse voice pages using a WWW browser (col. 7, lines 20-23). WWW browsers have the inherent ability to display the URL of the page being displayed. Therefore, when the user is browsing the yellow page the browser would display (send a notification to the user) of the yellow page URL (independently accessible address associated with the recorded audio file).

Art Unit: 2645

Therefore, it would have been obvious to a person of ordinary skill in the art to add a sent notification to the recording user specifying the address as discussed above and as taught by Uppaluru to the yellow page publishing system of Uppaluru.

The suggestion/motivation for doing so would have been to increase yellow page accuracy and effectiveness by visually reviewing using a WWW browser a yellow page that was recently published on the WWW.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.

r.g.f. R.C.F.
July 28, 2001

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

